

# Notice of Allowability

Application No.

10/768,489

Examiner

Medina A. Ibrahim

Applicant(s)

STEPHENS ET AL.

Art Unit

1638

## -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the telephone interview of 08/04/05.
2. ☒ The allowed claim(s) is/are 1-16.
3. ☐ The drawings filed on \_\_\_\_\_ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All    b) ☐ Some\*    c) ☐ None    of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  6. ☐ CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.
    - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
      - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

### Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08),  
Paper No./Mail Date \_\_\_\_\_
4. ☐ Examiner's Comment Regarding Requirement for Deposit  
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413),  
Paper No./Mail Date \_\_\_\_\_
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_

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### EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Steven Callistein on 08/04/05.

The application has been amended as follows:

In The Specification:

On page 49 of the specification (see the amendment of 6/15/05), the last two sentences, " U.S. Pant Variety Protection of Soybean Variety XB19U04 may be applied for. Unauthorized seed multiplication prohibited. " have been deleted.

In The Abstract:

The abstract on page 52 of the specification has been replaced with the following:

----According to the invention, there is provided a novel soybean variety, designated XB19U04. This invention thus relates to the seeds of soybean variety XB19U04, to the plants of soybean XB19U04, and to methods for producing a soybean plant by crossing soybean variety XB19U04 with another soybean plant, using XB19U04 as either the male or the female parent. This invention also relates to

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methods for introducing a transgene into soybean variety XB19U04 and plants produced by said methods. ----

In The Claims:

At claims 3-4, the first "part" has been replaced with ---or a part thereof---.

At claim 6, "plant tissue" in line 2 has been replaced with ---a plant part---.

At claim 7, "having all" in line 2 has been replaced with ---wherein the regenerated plant has all of -----.

At claim 8, ---progeny--- has been inserted before the last "soybean" in line 3.

Claim 9 (New). A method of producing a herbicide resistant soybean plant comprising introducing a transgene conferring herbicide resistance into the plant of claim 2.

Claim 10 (New). A herbicide resistant soybean plant produced by the method of claim 9.

Claim 11 (New). The soybean plant of claim 10, wherein the transgene confers resistance to a herbicide selected from the group consisting of glyphosate, sulfonylurea, imidazolinone, glufosinate, triazine, and benzonitrile.

Claim 12 (New). A method of producing an insect resistant soybean plant comprising introducing a transgene conferring insect resistance into the soybean plant of claim 2.

Claim 13 (New). An insect resistant soybean plant produced by the method of claim 12.

Claim 14 (New). A method of producing a disease resistant soybean plant comprising introducing a transgene that confers disease resistance into the soybean plant of claim 2.

Claim 15 (New). A disease resistant soybean plant produced by the method of claim 14.

Claim 16 (New). The soybean plant of claim 13, wherein the transgene encodes a *Bacillus thuringiensis* polypeptide.

### **REASONS FOR ALLOWANCE**

The following is an examiner's statement of reasons for allowance: Applicant has developed a soybean variety XB19U04 which is properly deposited under 37 CFR 1.801-1.809. Numerous morphological and physiological characteristics of soybean variety are taught in Tables 1 and 2 (pp. 14-15) of the specification. The closest prior art is the soybean cultivar 92B63 of Freestone (US 6,326,529). However, soybean cultivar XB19U04 differs from the prior art cultivar at least in that it has a relative maturity group 1 and subgroup 9, resistance to Race 3 cyst nematode and also differs in seed oil and protein contents (Table 2). The prior art does not teach or fairly suggest any soybean

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cultivar that has the combination of all the traits as listed in Tables 1 and 2.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### **Contact information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Medina A. Ibrahim whose telephone number is (571) 272-0797. The Examiner can normally be reached Monday -Thursday from 8:00AM to 5:30PM and every other Friday from 9:00AM to 5:00 PM. Before and after final responses should be directed to fax nos. (703) 872-9306 and (703) 872-9307, respectively.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Dr. Amy Nelson, can be reached at (571) 272-0804.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

8/02/05

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MEDINA A. IBRAHIM  
PATENT EXAMINER

